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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JILL E. BARAD, JEANETTE CORCUERA, GREG VINEYARD,
DARIAN PASTERSKI, JOE SCULLY, JOHN WATSON,
ROY KANESHIRO, BRIAN CHANNELL, JEAN CHU,
NANCIE MARTIN, SIMON CHEUNG SHU KEUN, and LI TAK CHEE

Appeal 2009-001962
Application 09/804,664
Technology Center 3700

Decided:¹ May 22, 2009

Before TONI R. SCHEINER, LORA M. GREEN, and
MELANIE L. MCCOLLUM, *Administrative Patent Judges*.

GREEN, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 6, 13, 20-25, and 27-34. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

The claims are directed to personalized toys and methods for marketing, manufacturing and delivering personalized toys. Claims 6, 13, 29, and 34 are representative of the claim(s) on appeal, and read as follows:

6. A customer-defined, packaged, personalized toy, comprising:
a package having an aperture;
a personalized toy in the package; and
printed material, separate from the toy and further including customer defined identifying material, supported on the package so that the identifying material is visible through the aperture of the package and where the identifying material includes a customer-defined intended recipient;
wherein the aperture is smaller than the printed material.
13. A package for displaying a personalized toy, the package comprising:
a flap, separate from the toy and having an inside and an outside,
where the inside of the flap faces the personalized toy;
an aperture in the flap; and
customer-defined identifying material separate from the flap and supported on the inside of the flap, wherein the customer-defined identifying material includes a customer-defined intended recipient.
29. A packaged toy, comprising:
a personalized toy;
customer-defined identifying material separate from the toy and adapted to be customized according to specifications created by a customer, the customer-defined identifying material including an indication of a customer-defined intended recipient; and

a package enclosing the personalized toy and the customer-defined identifying material;

wherein the package has a flap covering at least a portion of the personalized toy and being adapted to support the customer-defined identifying material, with at least a portion of the identifying material visible from the exterior of the package.

34. A customer-defined, packaged, personalized toy, comprising:
a package;
a personalized toy in the package;
customer-defined identifying material, separate from the toy and supported on the package;
an aperture in the package positioned so that at least a portion of the identifying material is visible through the aperture of the package;
wherein the visible portion of the identifying material blocks the aperture, preventing the viewing of the personalized toy from the exterior of the package.

The Examiner relies on the following evidence:

Zerbo, Jr. U.S. 3,144,932 Aug. 18, 1964

We affirm.

ISSUE(S)

The Examiner finds that claims 6, 13, 20-25, and 27-34 are anticipated by Zerbo.

Appellants contend that all of the independent claims on appeal, *i.e.*, claims 6, 13, 29, and 34, all require limitations that are not disclosed or suggested by Zerbo.

Thus, the issue on appeal is: Have Appellants demonstrated that the Examiner erred in finding that all of the limitations of the independent claims on appeal are disclosed or suggested by Zerbo?

FINDINGS OF FACT

FF1 According to the Specification, the “present invention relates generally to personalized toys and methods for marketing, manufacturing and delivering personalized toys,” wherein “[t]he toys may include virtually any type of toy, such as a doll.” (Spec. 1.) The Specification exemplifies a doll and its clothing, but notes “it is intended that the invention include a method to make many other types of personalized toys, such as toy vehicles, race sets, construction sets, and games.” (*Id.* at 8.)

FF2 The Specification teaches that the “present invention allows a user to create a personalized toy through interactive computer programs, receiving immediate feedback on changes made to the toy.” (*Id.* at 2.)

FF3 The Examiner rejected claims 6, 13, 20-25, and 27-34 under 35 U.S.C. § 102(b) as being anticipated by Zerbo (Final Rejection 2).² As Appellants do not argue the dependent claims separately, they stand or fall with the independent claim from which they depend. 37 C.F.R. § 41.37(c)(1)(vii).

FF4 Figures 1, 2, and 6 of Zerbo are reproduced below.

² The Examiner also rejected claims 6, 20, and 21 under 35 U.S.C. § 112, second paragraph (Final Rejection 2). As the Examiner does not respond to Appellants’ arguments made in the Appeal Brief in the Examiner’s Answer, we summarily reverse this rejection.

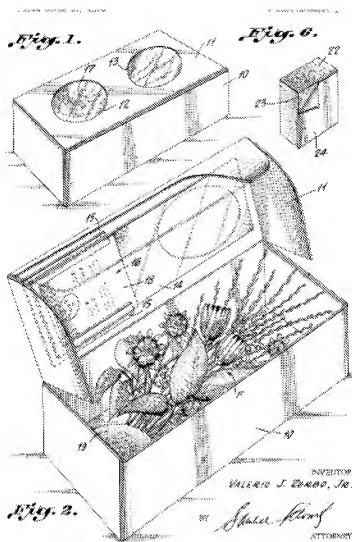


Figure 1 is a perspective view of the combination package of the artificial flowers of Zerbo; Figure 2 is an enlarged perspective view of the package showing the floral components in the box together with the Styrofoam mounting block; and Figure 6 illustrates a modified shape of the mounting block for placement in a rectangular receptacle (Zerbo, col. 2, ll. 13-38).
FF5 The Examiner finds that Zerbo discloses all of the limitations of independent claims 6, 13, 29, and 34 (Final Rejection 3-4).

FF6 The Examiner finds that the flowers of Zerbo read on a toy, as the flowers “*can be used for amusement or diversion.*” (*Id.* at 4.)

FF7 The Examiner finds further that Zerbo teaches printed matter separate from the toy, including customer-defined identifying material supported on the package so that it is visible through the aperture, wherein the customer-defined identifying material includes a customer defined recipient, *i.e.*, the person who purchases or receives the package in the particular desired configuration (*id.* at 3).

FF8 The Examiner rejects claims 6, 13, 20-25, and 27-34 under 35 U.S.C. § 103(a) as being obvious over Zerbo (*id.* at 5).

FF9 The Examiner notes that “Zerbo discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claims(s).” (*Id.*)

FF10 The Examiner concludes that it

would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the customer-defined identifying material with an indication of a customer-defined recipient, a toy name, or a story since it would only depend on the intended use of the assembly and the desired information to be displayed.

(*Id.*)

FF11 Citing *Gulack*, the Examiner finds that:

The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of instructional or aesthetic indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the

printed matter e.g. customer-defined intended recipient, a toy name, or a story, and the substrate e.g. package insert, which is required for patentability.

(Final Rejection 5.)

FF12 Zerbo “relates to ‘do-it-yourself’ floral arrangement kits, and more particularly is concerned with combination packages of artificial flowers with supporting means therefor which are sold as combined packages and which are adapted to be assembled by a purchaser of the packages in a manner to guarantee the production of esthetic floral arrangements.” (Zerbo, col. 1, ll. 10-16.)

FF13 Zerbo teaches that the essential components of an artistic floral arrangement are packaged “in a box which also contains a porous block of material of predetermined shape adapted to have impaled therein the stems of artificial plants in the box according to an instruction guide, also forming part of the package.” (*Id.* at col. 1, ll. 17-22.)

FF14 An object of Zerbo is “to make possible the marketing of artificial flowers in predetermined groups of species to attain a large number of diverse floral arrangements, leaving to the judgment of the purchaser the ultimate selection of any desired floral arrangement which is displayed pictorially through a display window provided in the cover of the box containing the artificial flowers, with the actual artificial flowers in the container visible through a second display window provided in the cover.” (*Id.* at col. 1, ll. 31-40.)

FF15 Zerbo teaches that the pictorial representation of the arrangement is printed on one side of the instruction card, with the instructions on the other

side (*id.* at col. 1, ll. 41-46). The arrangement may also be designated by name, which may also be imprinted on a label (*id.* at col. 3, ll. 4-12). FF16 “Toy”³ may be defined as “an object, often a small representation of something familiar, as an animal or person, for children or others to play with; plaything,” or as “something that serves for or as if for diversion, rather than for serious practical use.” FF17 “Personalize”⁴ may be defined as “to make personal, as by applying a general statement to oneself.”

PRINCIPLES OF LAW

During prosecution before the Office, claims are to be given their broadest reasonable interpretation consistent with the Specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy Of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989). Moreover, it is during prosecution that applicants have “the opportunity to amend the claims to obtain more precise claim coverage.” *American Academy*, 367 F.3d at 1364.

³ toy. Dictionary.com. *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. <http://dictionary.reference.com/browse/toy> (accessed: April 30, 2009).

⁴ personalize. Dictionary.com. *Dictionary.com Unabridged (v 1.1)*. Random House, Inc. <http://dictionary.reference.com/browse/personalize> (accessed: April 30, 2009).

To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.

Karsten Mfg. Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383 (Fed. Cir. 2001).

We recognize that “[t]he Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art,” and “may not disregard claim limitations comprised of printed matter.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citations omitted); *see also In re Nehls*, 88 USPQ2d 1883 (BPAI 2008). In determining whether the printed matter imparts patentability to a claimed invention, however, “the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate.” *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983). The following cases are illustrative.

At issue in *In re Gulack* was a claim requiring a band, ring, or set of concentric rings; a plurality of digits imprinted on the band at regularly spaced intervals; and an algorithm by which the appropriate digits were developed. 703 F.2d at 1382. The court found that there was a functional relationship between the printed matter and the substrate that was different than that disclosed by the prior art, and reversed the Board’s conclusion to the contrary. *Id.* at 1387.

The claims in *In re Lowry* were drawn to a memory containing a stored data structure comprising a plurality of attribute data objects (ADOs). 32 F.3d at 1580-81. The Board analogized the ADO’s to printed matter, and determined that there was no functional relationship between the printed

matter, the ADOs, and the substrate, *i.e.*, the memory. *Id.* at 1582. The court reversed, finding that the data structures were not analogous to printed matter, but instead defined functional characteristics of the memory. *Id.* at 1583. Moreover, the court noted that even if the data structures were analogous to printed matter, the “PTO did not establish that the ADOs, within the context of the entire claims, lack a new and nonobvious functional relationship with the memory.” *Id.* at 1584.

Finally, in *In re Ngai*, 367 F.3d 1336 (Fed. Cir. 2004), at issue was a claim to a kit containing a buffer agent and instructions, with the only difference being the content of the instructions. *Id.* at 1338. The court distinguished its finding in *Gulack*, finding that the “addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band [in *Gulack*].” *Id.* at 1339.

ANALYSIS

Appellants argue that all of the independent claims on appeal, *i.e.*, claims 6, 13, 29, and 34, all require limitations that are not disclosed or suggested by Zerbo. (App. Br. 13.)

First, Appellants argue that “Zerbo does not disclose a toy,” but “[i]nstead, . . . discloses flower arranging kits that include artificial flowers, a block of foam, and instructions for mounting the flowers in the foam.” (*Id.* at 14.) In fact, Appellants assert, “Zerbo repeatedly describes the artificial flowers of the kits as having stems that may be ‘impaled’ into a block of foam . . . , a concept that is inconsistent both with the idea of a ‘toy’ as presented in the specification, and with the Examiner’s own interpretation of

the flowers as being something ‘which can be used for amusement or diversion.’” (*Id.*)

Appellants acknowledge that the claims must be given the broadest reasonable interpretation in light of the Specification, but assert that the Examiner’s interpretation is inconsistent with the Specification, which discloses the specific example of a doll, as well as toy vehicles, race sets, construction sets, and games, “all of which reflect a standard meaning of the term to refer to an object for children to play with.” (*Id.* at 15.) Appellants assert, “[s]imply put, the claims recite a commonly-used term with a generally accepted meaning: an object for children to play with.” (*Id.* at 17.)

First, we note that this argument does not apply to independent claim 13, as claim 13 is drawn to a “package for displaying a personalized toy,” and thus the recitation of “toy” is drawn to a statement of intended use of the package, and does not limit the package.

Second, we give “toy” its broadest reasonable interpretation in view of the Specification. Appellants argue that toy should be interpreted as being an object for children to play with. The Specification, however, does not give the term “toy” any special definition, but merely provides examples such a dolls, racing sets, and games (FF1). Dolls, for example, however, are not always intended for a child to play with, but are also collector’s items that may never be taken out of the box. In addition, Appellants do not argue or point to anything in the Specification that would limit the age of child for which the toy is intended. Thus, while the flower arrangement set of Zerbo may not be appropriate for a toddler of one, it may be very appropriate for a child of thirteen. We therefore give toy the broadest reasonable

interpretation and interpret toy as “something that serves for or as if for diversion, rather than for serious practical use” (FF16), and thus find that the artificial flower arrangement kit of Zerbo meets that limitation of independent claims 6, 29, and 34, as well as the intended use limitation of claim 13.

Second, Appellants argue that Zerbo fails to disclose “*a personalized toy*.” (App. Br. 18.) Appellants assert that “*“personalized toy”* is used in the specification to indicate, in the general sense, a toy possessing some degree of personalization.” (*Id.*) Moreover, Appellants assert, “the specification is replete with references to a customer interacting via computer programs to select configurations of components and otherwise personalize a toy doll prior to its manufacture and shipment.” (*Id.* at 18-19.) Zerbo, Appellants contend, “discloses flower arranging kits that include artificial flowers, a block of foam, and instructions for ‘impaling’ the flowers in the foam,” and provides instructions to achieve a desirable arrangement, but “is silent with regard to customer interaction with the product prior to its manufacture and packaging.” (*Id.* at 19.)

Again, we note that this argument does not apply to independent claim 13, as claim 13 is drawn to a “package for displaying a personalized toy,” and thus the recitation of “personalized toy” is drawn to a statement of intended use of the package, and does not limit the package.

The Specification teaches that the present invention “allows a user to create a personalized toy through interactive computer programs, receiving immediate feedback on changes made to the toy.” (FF2.) But that is a process limitation, not a product limitation, and each of the independent

claims is drawn to a product. Once the “toy” such as a doll is made and packaged, it may be mass marketed or sent to a single user, but there is nothing in the claim that limits it to one or the other. We therefore conclude that “personalized” is a process limitation that does not limit the product of independent claims 6, 29, and 34, nor the intended use of independent claim 13.

In addition, while the Specification provides an example of how the toy may be personalized, it does not provide a specific definition of the term “personalize.” “Personalize” may be defined as to make personal. Zerbo teaches that the invention allows for marketing of artificial arrangements in predetermined groups of species to attain a large number of diverse floral arrangements, leaving to the judgment of the purchaser the ultimate selection of any desired floral arrangement which is displayed pictorially through a display window (FF14). Thus, the buyer purchases the arrangement that appeals to them, making it “personal.”

Third, Appellants argue that Zerbo fails to disclose “*customer-defined identifying material*.” (App. Br. 20.) Appellants argue that “during component configuration, a customer may also input identifying information . . . such as a name for the toy as defined by the customer, the identity of an intended recipient as defined by the customer, as well as the customer-selected component configurations.” (*Id.* at 20-21 (citing Specification, p. 10, l. 2).) In contrast, Appellants contend, the “instructions and the pictorial representation of the finished floral arrangement [of Zerbo] are provided without regard to customer input.” (App. Br. 21.)

Fourth, Appellants argue that Zerbo fails to disclose “*a customer-defined intended recipient*.” (App. Br. 22.) Specifically, Appellants contend, “Zerbo fails to provide any indication that the ‘printed material 18’ of a kit does-or even can-include an identification of the individual who ultimately purchases or receives the kit.” (*Id.*) Moreover, Appellants assert, “‘*customer-defined intended recipient*’ refers to information provided by a customer prior to ordering a toy and thus, prior to its manufacture, delivery, and sale.” (*Id.* at 23.)

First, we agree with the Examiner that the limitations of “customer-defined identifying material” and “customer-defined intended recipient” are both printed matter for which there does not exist any new or unobvious functional relationship to the substrate, and thus do not limit the subject matter of independent claims 6, 13, 29, and 34.

Claim 6⁵ recites “printed material, separate from the toy and further including customer defined identifying material, supported on the package so that the identifying material is visible through the aperture of the package and where the identifying material includes a customer-defined intended recipient.” The relationship of the printed matter to the substrate, *i.e.*, the package, is not new or unobvious as Zerbo teaches printed matter, *i.e.*, the pictorial representation of the arrangement, the name of the arrangement, as well as the instructions for making the arrangement, that has the same relationship to the packaging as the claimed printed matter—the only thing that is different is the content of that printed matter.

⁵ We note that independent claims 13, 29, and 34 have similar recitations, and thus the discussion applies equally well to those claims.

Thus, we find that the instant situation is most analogous to that in *Ngai*, wherein the court found that the “addition of a new set of instructions into a known kit does not interrelate with the kit in the same way as the numbers interrelated with the band [in *Gulack*].” *Ngai*, 367 F.3d at 1339. *Gulack* is distinguishable because in that case, the claims recited “three key elements: (1) a *band* . . . ; (2) a plurality of individual *digits* imprinted on the band or ring at regularly spaced intervals; and (3) an *algorithm* by which the appropriate digits are developed.” *Gulack*, 703 F.2d at 1382. With the digits generated by the algorithm printed on it, the band could be used “to perform magic tricks or to display various aspects of number theory.” *Id.* at 1383. The *Gulack* court held that a new and unobvious functional relationship between the printed matter and the substrate had been shown: the looped structure of the substrate and the particular digits printed on it interrelated to give the claimed product a property it would not have had if either the structure or the digits were changed. *Id.* at 1386. In the instant claims, however, as in *Ngai*, the printed matter does not give the substrate, *i.e.*, the packaging, a different property than it would have if the printed matter were changed.

In fact, that conclusion is born out by Appellants’ own Specification and arguments. According to Appellants, the content of the printed matter may be changed by the consumer during the personalization process, whereas the in *Gulack*, the claimed product would have a different property if the printed matter, *i.e.*, the digits on the band, were changed.

Appellants also assert that Zerbo does not render the claims obvious (App. Br. 24). Appellants argue that “the limitation of ‘*customer-defined*

intended recipient’ is not an intended use, but rather is a structural and/or functional limitation,” as it “indicates the result of a customer action performed during configuration of the personalized toy and prior to its manufacture, packaging, or delivery.” (*Id.* at 25.) As to the Examiner’s citation of *Gulack*, Appellants argue that “the Examiner fails to demonstrate the *absence* of a functional relationship between the printed matter and the substrate.” (App. Br. 26.) According to Appellant, “the limitation ‘customer-defined intended recipient’ exploits the nature of the printed material: the latter is configured by the customer prior to the manufacture and packaging of the personalized toy, and is incorporated in the packaging of the toy.” (*Id.* at 27.)

As we have already found that Zerbo anticipates the subject matter of independent claims 6, 13, 29, and 34, and as anticipation is the epitome of obviousness, *In re McDaniel*, 293 F.3d 1379, 1385 (Fed. Cir. 2002), we summarily affirm the obviousness rejection as well.

CONCLUSION(S) OF LAW

We find that Appellants have not demonstrated that the Examiner erred in finding that all of the limitations of the independent claims on appeal are disclosed or suggested by Zerbo.

We thus affirm the rejection of claims 6, 13, 20-25, and 27-34 under 35 U.S.C. § 102(b) as being anticipated by Zerbo, as well as the rejection of claims 6, 13, 20-25, and 27-34 under 35 U.S.C. § 103(a) as being obvious over Zerbo.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

cdc

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